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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/856,452	07/27/2001	Gerold Tebbe	011104	9150

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EXAMINER

ZIRKER, DANIEL R

ART UNIT	PAPER NUMBER
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1771

DATE MAILED: 07/31/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

Applicant(s)

Examiner

Group Art Unit

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE -3- MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

## Status

- ☐ Responsive to communication(s) filed on \_\_\_\_\_
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- ☒ Claim(s) 1-13 is/are pending in the application.
- ☐ Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- ☒ Claim(s) 1-13 is/are rejected.
- ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- ☐ Claim(s) \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119 (a)-(d)

- ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☒ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been received.
- ☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_
- ☒ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

## Attachment(s)

- ☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 3
- ☒ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Interview Summary, PTO-413
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Other \_\_\_\_\_

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1. This application does not contain an abstract of the disclosure as required by 37 CFR 1.72(b). An abstract on a separate sheet is required.

2. The following is a quotation of the second paragraph of 35 U.S.C. § 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1-13 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. More particularly, the claims in their present state are filled with a significant number of informalities, translation related errors and need to be substantially revised, if not entirely rewritten. The applicant is encouraged to use Jepson claim format instead of "characterised". In claim 1 the phrase "for the, at least temporary, attachment" is believed to be poor grammar. In claim 2, line 3 it is suggested to change "hardened" to "cured" or equivalent language. In claim 3 the phrase "is carried by" is vague and indefinite, as well as being poor grammar. In claim 4 "has microcapsules" is also poor grammar. In the preliminary amendment revising claims 7, 8, 10 and 13, the insertion of the number 1 by itself is inadequate. In claims 8 and 9, the word "it" is clearly informal.

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4. The specification is objected to under 35 U.S.C. § 112, first paragraph, as failing to contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise and exact terms as to enable any person skilled in the art to make and use the invention. More particularly, applicant's disclosure with respect to the presence of paint containing microcapsules, as well as the presence of a bonding agent which holds the microcapsules together such as found at pages 5 and 6 of the specification appears to the Examiner to be little more than an invitation to experiment. That is, no parameters regarding the properties or the chemical structure of either the microcapsules or bonding agent are set forth anywhere in the specification and nothing on the record has been shown to indicate that such parameters are well known to one of ordinary skill in the paint patch art. Additionally, although perhaps not a 112 first paragraph rejection, the specification at pages 2-4 should not contain claim numbers in the description of the particular subject matter discussed, and should be so amended to reflect the disclosure which is being referred to.

Claims 4-7 are rejected under 35 U.S.C. § 112, first paragraph.

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless --

5. (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1-3 are rejected under 35 U.S.C. § 102(b) as being anticipated by either Speakman or Berner et al., the latter being the U.S. equivalent of EP 0361351. The references each appear to disclose (note particularly Speakman, the Abstract, Figure 1, column 1 line 52 - column 2 line 2, column 2 line 50 - column 3 line 2; Berner et al., column 1 lines 43-68; column 2 lines 4-9, column 5 lines 29-37, column 5 line 61 - column 6 line 6, column 6 lines 11-15) a repair material or patch for repairing paint layers on automobiles and the like, the article comprising a flexible substrate having on one surface a paint layer and on the opposing opposite surface an adhesive for bonding the flexible layer to the painted surface to be repaired. Note also that it is not necessary for the paint layer to be cured.

8. The following is a quotation of 35 U.S.C. § 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability

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shall not be negated by the manner in which the invention was made.

9. Claims 4-13 are rejected under 35 U.S.C. § 103(a) as being unpatentable over either Speakman or Berner et al. The references are again relied upon substantially as set forth above. With respect to claims 4-7 which relate to the properties of the paint layer, particularly the presence of microcapsules containing paint, the Examiner believes that the presence of such microcapsule containing paint elements is a parameter well within the ordinary skill of the art for the skilled artisan who is versed in the utilization of paint. Alternatively, note that Tashiro et al. U.S. 5,741,591, cited as evidence of the state of the art, discloses (note particularly the Abstract, column 2 lines 19-27, column 2 lines 50-67) that paint containing microcapsules can be utilized using encapsulating pigments to form a product having an outer surface which exhibits a highly attractive, superhigh-gloss surface (column 2 lines 19-23). The remaining parameters, such as the presence of punched out pieces of materials which can have a variety of geometries (applicant's claims 8 and 9), as well as the presence of a kit containing suitable elements to form the repair patch when it is used in its intended environment in the workplace are each believed to be, if not expressly or inherently disclosed, obvious modifications to one of ordinary skill, in the absence of unexpected results.

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10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Note also Owens et al. and Rosenheim.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel Zirker whose telephone number is (703) 308-0031. The examiner can normally be reached on Monday-Thursday from 8:30 A.M. to 6:00 P.M. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris, can be reached on (703) 308-2414. The fax phone number for this Group is (703) 872-9310.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0661.

Dzirker:cdc

July 26, 2002

DANIEL ZIRKER  
PRIMARY EXAMINER  
GROUP 1900-

1700

*Daniel Zirker*